UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,225	11/20/2001	Tony F. Rodriguez	P0490	4167

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DIGIMARC CORPORATION
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EXAMINER
RAMAN, USHA

ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 February 2008</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>17-27</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>17-27</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>10-15-07</u>.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

Miscellaneous

1. Please note that the examiner of record has changed.

Response to Arguments

2. Applicant's arguments filed on February 5th 2008 in response to restriction requirement made on January 7th, 2008 have been considered and are persuasive. Therefore all the of pending claims (17-27) will be examined.

3. Applicant's arguments filed on October 15th, 2007 have been fully considered but they are not persuasive.

    Applicant argues that claim 21 is fully supported by applicant's specification by incorporation of reference patent 6,947,571. The examiner respectfully disagrees. In particular the '571 patent fails to disclose watermark data embedded in the video content received by a cell phone. Additionally, while claim 21 recites "a portable apparatus" operative to make phone calls, receive email and video content, the '571 patent only discloses a cell phone and therefore lacks sufficient disclosure to support the broader genus that is claimed.

    Applicant argues (see page 9) with respect to the priority given to Chen stating that, "that merely entitles to be given prior art effect as of its international filing data, which was June 2001". A closer look at MPEP §706.02(a) shows however that, "the prior art date of a reference under 35 U.S.C. 102(e) maybe the international filing date (if all three conditions noted above are met) or *an earlier U.S. filing date* for which priority or benefit is properly claimed". Therefore Chen is entitled to the effective prior art date of July 2000. Furthermore, 37 CFR 1.14

indicates that unpublished applications whose benefit is claimed under 35 U.S.C.

119(e), 120, 121 or 365 in an international application that was published in

accordance with PCT Article 21(2) maybe provided to any person upon written

request and payment of the appropriate fee. See 37 CFR 1.14 (iv) and (v).

Therefore applicant's arguments stating that, "Since the office has not made any

showing as to its contents, applicant respectfully submits that rejection based on

Chen (PCT) have not met a prima facie threshold" are found unpersuasive.

Applicant arguments (see Remarks, page 9) stating that, "claim 17 requires

processing circuitry operative to launch a web browser (if one is not already

running), utilize the web browser in accordance with decoded watermark data to

obtain auxiliary data content and render content for output including both first and

the auxiliary content" have been noted. However Chen states that extracted data

maybe in any form, including HTML form, and Meyers also indicates that various

executable codes maybe embedded, including java script, and that based on the

MIME type of the executable code, *appropriate execution environment is instantiated*

(see Meyers column 7, lines 63-34). As such the modified system comprises a web

browser for rendering content for output including both the first and second content

data and the auxiliary content.

For the reasons stated above, the rejection is maintained.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 21-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 recites the limitation of "a portable apparatus" that is "operative to make phone calls, send email and displayed received video data"...."the apparatus characterized by a watermark decoder operative to decode plural bit watermark data steganographically embedded 'in band' within digital audio or video content data". Applicant's specification incorporates in by reference US 09/571,422, now issued as US Pat. 6,947,571. It is noted that the '571 patent discloses a portable apparatus comprising a cell phone with email access, wherein the cell phone is operative to make phone calls. The '571 patent further indicates that a display screen on such phones can be used to display incoming video data. The '571 patent additionally discloses that cell phones have the ability to capture image data, wherein the '571 patent discloses various instances of decoding "bedoop" data from captured images. The '571 patent is however lacking sufficient disclosure that supports the feature of such bedoop data being staganographically embedded in band within the digital audio or video content data received by the cell phone. Furthermore, the examiner

notes that the '571 patent only identifies a single specie (i.e. a cell phone) of the portable apparatus. The '571 patent and applicant's instant disclosure therefore lacks adequate written description for the broader genus claimed under the "portable apparatus".

Claim 20 recites the limitations that a consumer electronic apparatus "launch a web browser, if a web browser is not already running". Applicant's specification incorporates in by reference US 09/571,422, now issued as US Pat. 6,947,571. The '571 patent discloses that a web browser is launched upon detection of the embedded bedoop signal, however the '571 patent lacks any teaching of a contemplation of "if a web browser is not already running" and only then launching the web browser.

Therefore applicant has failed to sufficiently establish that applicant was in possession of the claimed invention at the time at the time the instant application was filed.

7. Claims 17-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "said processing circuitry" operative to "define a software interface" and claim 21 recites the limitation, "causing said processor to *define* a layered stack of protocols". The scope of the word "define" is unclear.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (f) he did not himself invent the subject matter sought to be patented.

9. Claims 21-27 are rejected under 35 U.S.C. 102(f) because the applicant did not

invent the claimed subject matter.

Application 09/571,422 (now US Pat. 6,947,571) disclose subject matter

being claimed in the instant application, wherein none of the inventors of the instant

application were part of the inventive entity of '422 application, thereby raising

ambiguity regarding inventorship on claims 21-27.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 17-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Chen

(WO 02/07425) in view of Meyers et al. (US Pat. 7,188,186).

With regards to claim 17, Meyers discloses a consumer electronic apparatus

for receiving content data with watermark data embedded "in band" within the

content data. Examples of such consumer electronic apparatus include among

other things, digital computer systems (see column 4, lines 24-28). Furthermore,

Meyers discloses an application such as the well known "Sonique" mp3 player may

render the content for output using output device, the rendered content including

both the first content data (e.g. music) and auxiliary content obtained through the

use of watermark data (see column 4, lines 55 -column 5, line 12). As such it is

noted that computer systems comprise a hardware layer and comprises plural higher

layers including an application layer at the higher level such as "Sonique" mp3

player. Meyers additionally discloses the step of launching a web browser if a web

browser is not already running and utilizing the browser to obtain the auxiliary

content (see column 7, lines 63-column 8, line 7).

Meyers discloses the step of decoding the embedded watermark wherein

software interface masking details of particular hardware design by which the

watermark decoder is implemented (see column 2, lines 44-47) however is silent on

the step of watermark decoding functionality provided by the watermark decoder can

be invoked by the apparatus.

In a similar field, Chen discloses a consumer electronic apparatus comprising

an input for receiving content data from the Internet (fig. 1A) and also including a

memory and an output device (PC containing memory and monitor, see page 38,

lines 1-2), the system further comprising a watermark decoder in the hardware layer

to decode data steganographically embedded "in band" with the received content

and to provide the decoded watermark data to a higher layer in the architecture (see

pages 37, lines 21-33 and page 38, lines 1-9), processing circuitry responsive to

instructions stored in the memory to execute a web browser in accordance with the

watermark decoded by the watermark decoder. Accordingly Chen is evidence to

one of ordinary skill in the art for decoding watermark at a hardware layer and subsequently providing the data to a higher layer (such as the presentation layer rendered in the system of Meyers).

All the claimed elements were known in the art and one ordinary skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

With regards to claims 18-20, the modified system is operative to decode plural bit watermark steganographically embedded within still image, audio or video content (see Meyers column 4, lines 21-24).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to USHA RAMAN whose telephone number is

(571)272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The

fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-direct.uspto.gov.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-

272-1000.

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